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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,456	05/03/2001	Michael W. Barry	TRSY-23,859	7206

25883 7590 08/04/2003
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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/848,456	Applicant(s) Barry et al		
	Examiner Mark Wallerson	Art Unit 2622		
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --				
Period for Reply				
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.				
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 				
Status				
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>May 19, 2003</u>				
2a) <input checked="" type="checkbox"/> This action is FINAL. 2b) <input type="checkbox"/> This action is non-final.				
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.				
Disposition of Claims				
4) <input checked="" type="checkbox"/> Claim(s) <u>32-37</u> is/are pending in the application.				
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.				
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.				
6) <input checked="" type="checkbox"/> Claim(s) <u>32-37</u> is/are rejected.				
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.				
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.				
Application Papers				
9) <input type="checkbox"/> The specification is objected to by the Examiner.				
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).				
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.				
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.				
Priority under 35 U.S.C. §§ 119 and 120				
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).				
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).				
*See the attached detailed Office action for a list of the certified copies not received.				
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).				
a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.				
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.				
Attachment(s)				
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)				
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)				
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____				
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____				
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)				
6) <input type="checkbox"/> Other: _____				

Art Unit: 2626

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **5/19/2003**.
2. This application has been reconsidered. Claims 32-37 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 32-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 32, that is no disclosure in the original specification of decrementing the first register for the print engine at the printing location if a comparison of the accumulated value with the toner level for the printing location indicates that the accumulated value in the first register is less than or equal to the toner level of the print engine. If Applicant believes this

Art Unit: 2626

rejection to be in error, Applicant is requested to provide SPECIFIC support for this subject matter in the claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear to the Examiner whether “a first register” in line 5 of the claim is the same as “the first register for the print engine” in line 8 of the claim.

7. Claims 32 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear to the Examiner (as best understood by claim 32) how the toner values of the pixels of the rasterized image could be decremented, since this value would be a static value.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2626

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakuma (U. S. 5,663,750) in view of Fukui et al (Fukui) (U. S. 5,124,751).

With respect to claim 32, Sakuma discloses a method for determining the amount of toner required to render a print job without prior knowledge of the toner level of a toner cartridge (column 2, lines 16-29); accumulating in a first register (22) toner values of all the pixels in a rasterized image prior to sending the job to the printer (column 4, lines 39-59); decrementing the register of the print engine at the printing location (which reads on updating the remaining ink value stored in the non-volatile memory) (column 8, lines 53-58) if a comparison of the accumulated value with the toner level indicates that the accumulated value is less than or equal to the toner level of the print engine (which reads on updating the remaining ink value stored in non-volatile memory 21 when more than a little ink remains) (column 5, line 59 to column 6, line 3), and sending the print job to the printing location for rendering (column 5, lines 59-61).

Sakuma differs from claim 32 in that he does not clearly disclose that the toner values are expressed as an incremental value ranging from zero to a maximum value. Fukui discloses an image forming apparatus wherein pixels of an image are classified in gradient levels ranging from 0 to 255 (column 5, lines 19-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakuma wherein the toner values are expressed as an incremental value ranging from zero to a maximum value. It would have been

Art Unit: 2626

obvious to one of ordinary skill in the art at the time of the invention to have modified Sakuma by the teaching of Fukui in order to determine the amount of toner to be supplied as disclosed by Fukui in column 2, lines 38-48.

Response to Arguments

10. Applicant's arguments with respect to claims 32-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. All claims are rejected.

12. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Art Unit: 2626

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

MARK WALLERSON
PRIMARY EXAMINER

Mark Wallerson